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Docket No. GTW-0152(P1415.2)**REMARKS**

Favorable reconsideration of the present patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In this Amendment claims 1, 13, 34, 47-48 and 50 are amended, and no claims are added or canceled (claims 31, 38, 40, 42 and 44 were previously canceled). As a result, claims 1-30, 32-37, 39, 41, 43 and 45-55 remain pending in the application. Support for the claim amendments can be found throughout the specification, for example, at pages 10-11 and 14-15 in the specification and elements 214/212 of Figure 6.

In the final Office Action of January 9, 2008, claims 1-10, 12-25, 27-30, 32-37 and 46-55 are rejected under 35 U.S.C. §103(a) in view of U.S. Patent 6,314,189 (Frederick), further in view of U.S. Patent 5,257,348 (Roskowski), yet further in view of U.S. Patent 5,287,189 (Ersöz) and yet even further in view of U.S. Patent 6,567,097 (Iwaki). Claims 11 and 26 are rejected under 35 U.S.C. §103(a) in view of Frederick, further in view of Roskowski, yet further in view of Ersöz yet further in view of Iwaki, and yet even further in view of U.S. Patent 6,154,600 (Newman). Claims 39, 41, 43 and 45 are rejected under 35 U.S.C. §103(a) in view of Frederick, further in view of Roskowski, yet further in view of Ersöz yet further in view of Iwaki, and yet even further in view of U.S. Patent 6,072,489 (Gough).

*Status of Application*

In the most recent Office Action of May 28, 2008 the claims stood rejected under a four-way §103 rejection. Independent claim 13 recites a host computer with four elements (processor, memory, video controller and video capture circuitry) and a display apparatus with four elements

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(screen, communication channel, microprocessor and connector). The Office relies upon the Frederick patent for six of the eight elements of claim 13, contending that three of these elements supposedly taught by Frederick are inherent in the Frederick device (processor, memory and screen). The Office cites the three other patents from the four-way §103 rejection to purportedly teach various aspects of the remaining elements. The Office does not discuss independent claims 1 and 34. The Office contends that claim 1 and claim 34 are rejected for the same rationale as claim 13 due to the similarity of the claims.

#### *Legal Standard for Inherency*

The Manual of Patent Examining Procedure (MPEP) provides guidelines for a feature to properly be considered inherent. For example, MPEP §2112 states:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>1</sup>

"The mere fact that a certain thing may result from a given set of circumstances is not sufficient."<sup>2</sup>

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."<sup>3</sup>

In accordance with the standards for inherency set forth in MPEP §2112, it is respectfully submitted that a number of the features alleged to be inherent in the Office Action cannot be properly maintained. In each instance of alleged inherency relied upon by the Office it would be possible for the Frederick device to be configured in a different manner or operate differently

<sup>1</sup> MPEP §2112 citing In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

<sup>2</sup> MPEP §2112 citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

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than the feature alleged to be inherent. This is sufficient to overcome the allegation of inherency since the allegedly inherent feature would then not "necessarily flow from the teachings of the applied prior art." Accordingly, it is respectfully requested that the next paper from the Office does not rely upon these allegations of inherency.

*§103 Rejection in view of Hypothetical Combinations of  
Frederick / Roskowski / Ersoz / Iwaki / Newman*

The §103 rejection of claims 1-10, 12-25, 27-28, 34-37, 46-53 and 55 in view of the hypothetical combination of Frederick, Roskowski, Ersoz and Iwaki, and the §103 rejection of claims 11 and 26 additionally in view of Newman are obviated in view of the present claim amendments. The rejection of claims 29-30, 32-33, 43 and 54 are respectfully traversed.

As discussed previously in regards to the microprocessor elements recited in claims 1, 13 and 34, it is agreed that the control electronics 82 of Frederick may be construed to encompass various "microprocessor" equivalents such as the microcontroller or logic circuitry of Frederick. However, it is believed that Frederick does not teach or suggest all the specific features recited in the microprocessor claim elements. For example, there is nothing that would lead one of ordinary skill in the art to modify the Frederick display device to be capable of "controlling a television feature of the display apparatus from the host computer system when said screen is operating in said interlaced format, and for enabling an overlay window" as recited in claim 34. Moreover, no particular display screen of Frederick is capable of both displaying interlaced images and also displaying noninterlaced images. The Office's contention of inherency in the Frederick device for several claim elements is again respectfully traversed. It is respectfully

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<sup>3</sup> MPEP §2112 citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

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submitted that the secondarily cited documents in the rejection—Roskowski, Ersoz, Iwaki and Newman—do not overcome the deficiencies of Frederick.

Accordingly, it is respectfully submitted that the Frederick, Roskowski, Ersoz, Iwaki and Newman patents, either taken singly or in hypothetical combination, do not teach the features of the claimed invention. Therefore, withdrawal of the §103 rejections is respectfully requested.

*§103 Rejection of Claims 47-48 and 50*

The §103 rejection of dependent claims 47-48 and 50 in view of the hypothetical combination of Frederick, Roskowski, Ersoz and Iwaki is obviated by the present claim amendments. It is believed the rejection cannot be maintained for at least the following reasons.

Dependent claims 47-48 and 50, added by the Amendment of October 24, 2007 and amended in the present paper, describe the embodiment depicted in Figure 6. The second connector coupled to the video capture circuitry recited in these claims is shown as the connector between Display 114 and ADC 226. The third connector is depicted as cable 214 in Figure 6. A careful review of the Frederick, Roskowski, Ersoz and Iwaki patents taken in their entirety do not reveal any such structure or functionality that falls within the scope of claims 47-48 and 50.

Accordingly, it is respectfully submitted that the Frederick, Roskowski and Ersoz patents, either taken singly or in hypothetical combination, do not teach the features of the claimed invention in claims 47-48 and 50.

*Claim Amendments*

Claims 47-48 and 50 are each amended herein to recite "a third connector coupled to the video capture circuitry and configured to receive the noninterlaced television output from the

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video capture circuitry.” Support for these claim amendments can be found throughout the specification, for example, at page 10 in the specification and elements 214/212 of Figure 6. It is believed that the prior art does not teach or suggest these features.

Claims 1, 13, and 34 are amended to recite “means for switching a mode of operation to either the interlaced mode of operation or the noninterlaced mode of operation.” Support for these claim amendments can be found throughout the specification, for example, at pages 11 and 14-15 in the specification. It is believed that the prior art does not teach or suggest these features.

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Docket No. GTW-0152(P1415.2)*Deposit Account Authorization / Provisional Time Extension Petition*

It is believed that a one-month extension of time is sufficient for this paper, and the accompanying RCE Transmittal attends to the required claim fees. However, to the extent necessary, a provisional petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-0439 and please credit any excess fees to such deposit account.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. However, in the event there are any unresolved issues, the Examiner is kindly invited to contact applicant's representative, Scott Richardson, by telephone at (571) 748-6200 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



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